

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/630,141
Applicant : John J. Giobbi
Filed : July 30, 2003
Title : Portable Data For Communicating With Gaming
Machine Over Wireless Link
TC/A.U. : 3714
Examiner : Jasson H. Yoo

Docket No. : 247079-000107USD2
Customer No. : 70243

Mail Stop Appeals
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

APPEALS BRIEF

Dear Commissioner:

This Appeal Brief is filed pursuant to the Appellants' appeal to the Board of Patent Appeals and Interferences ("Board") from the final rejection of claims 101-104 and 106-125 in the April 28, 2009 Final Office Action. (Exhibit B). A Notice of Appeal is filed herewith. The due date for this Appeal Brief is two months from the mailing date of the Notice of Appeal and this brief is being filed with a petition for a two month extension of time.

1. REAL PARTY IN INTEREST

The real party in interest of the above-captioned patent application is the Assignee, WMS Gaming, Inc.

2. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellant that will have a bearing on the Board's decision in an appeal of this matter.

3. STATUS OF THE CLAIMS

Claims 101-104 and 106-125 remain in the application. Claims 1-100 and 105 have been canceled previously.

4. STATUS OF AMENDMENTS

No amendments have been made subsequent to the last amendment filed on July 14, 2008.

5. SUMMARY OF CLAIMED SUBJECT MATTER

Aspects of the present inventive subject matter include, but are not limited to, methods and systems for but are not limited to, methods and systems for wireless activation of game features as shown in Figs. 1-2. Claim 101 generally relates to a method of operating a gaming terminal 10. *See* ¶ 11, Figs. 1-2, U.S. Publication No. 2004/0029635¹ (Exhibit A), Specification, p. 4, ll. 2-23. A wireless transmission link is established with a portable data unit 14 carried by an individual. (Ex. A, ¶¶ 11-12, 21, Specification, p. 4, ll. 8-11, 18-21, p. 7, l. 31 to p. 8, l. 1). The portable data unit 14 stores information associated with the individual. (Ex. A, ¶¶ 16, 22, Specification, p. 6, ll. 7-10, p. 8, ll. 8-17). The information associated with the individual is transmitted to the gaming terminal 10. (Ex. A, ¶ 12, Specification, p. 4, ll. 21-22). The operation of the gaming terminal 10 is changed in response to the transmitting. (Ex. A, ¶ 14, Specification, p. 5, ll. 12-22). The gaming terminal may be changed to a first mode associated with the individual or a second mode associated with the individual depending upon at least one

¹ The Publication for the application at issue is being attached for convenience as Exhibit A. Applicant is also providing the corresponding specification page and line number in this and following sections.

of (i) a distance between the portable data unit and the gaming terminal and (ii) a period of time for which the portable data unit is detected as being in the presence of the gaming terminal, the first mode being different from the second mode. (Ex. A, ¶¶ 14, 47-48, Specification, p. 4, ll. 11-25, p. 15, l. 19 to p. 16, l. 13).

Claim 102 is generally directed toward a method of operating a gaming machine 10. (Ex. A, ¶ 11, Specification, p. 4, ll. 2-6, Figs. 1-2). The presence of a passerby proximate to the gaming machine is detected by the gaming machine 10. (Ex. A, ¶ 14, Specification, p. 5, ll. 9-16). The passerby is not playing the gaming machine 10. (Ex. A, ¶ 14, Specification, p. 5, ll. 12-15). The detection includes establishing a wireless transmission link between a first wireless transceiver 12 in the gaming machine 10 and a second wireless transceiver 16 disposed in a portable data unit 14 carried by the passerby. (Ex. A, ¶¶ 11-12, 21, Specification, p. 4, ll. 8-11, p. 7, l. 31 to p. 8, l. 1). The portable data unit includes information for allowing an identity of the passerby to be determined. (Ex. A, ¶¶ 16, 22, Specification, p. 6, ll. 7-10, p. 8, ll. 8-17). The gaming machine 10 is operated in a first mode associated with the passerby in response to detecting the presence of the passerby by at least one of detecting the presence of the passerby within a first predetermined distance of the gaming machine or detecting the presence of the passerby for at least a first predetermined period of time. (Ex. A, ¶ 14, Specification, p. 5, ll. 11-16). The gaming machine 10 is operated in a second mode associated with the passerby in response to detecting the presence of the passerby by at least one of detecting the presence of the passerby within a second predetermined distance of the gaming machine or detecting the presence of the passerby for at least a second predetermined period of time. (Ex. A, ¶ 14, Specification, p. 5, ll. 19-22). The second mode is different from the first mode, the second

predetermined distance is different from the first predetermined distance, and the second predetermined period of time is different from the first predetermined period of time. (Ex. A, ¶ 14, Specification, p. 5, ll. 11-25).

Claim 112 is generally directed toward a method of operating a gaming machine 10. (Ex. A, ¶ 11, Specification, p. 4, ll. 2-6, Figs. 1-2). The presence of a first passerby is detected by a gaming machine 10 by at least one of detecting the presence of the passerby within a first predetermined distance of the gaming machine or detecting the presence of the passerby for at least a first predetermined period of time, the passerby not interacting with the gaming machine. (Ex. A, ¶ 14, Specification, p. 5, ll. 12-16). The operation of the gaming machine 10 is modified according to an attract mode specific to the first passerby in response to the detecting the presence of the first passerby based on first information wirelessly communicated between the gaming machine 10 and a first portable data unit 14 carried by the first passerby. (Ex. A, ¶¶ 11-12, 14, 21, Specification, p. 4, ll. 8-11, 18-21, p. 5, ll. 16-19, p. 7, l. 31 to p. 8, l. 1). The presence of a second passerby is detected by the gaming machine 10 by at least one of detecting the presence of the passerby within a second predetermined distance of the gaming machine 10 or detecting the presence of the passerby for at least a second predetermined period of time. (Ex. A, ¶ 14, Specification, p. 5, ll. 19-25). The second predetermined distance is different from the first predetermined distance and the second predetermined period of time is different from the first predetermined period of time. (Ex. A, ¶ 14, Specification, p. 5, ll. 11-25). The operation of the gaming machine 10 is modified in response to the detecting the second passerby according to a play mode specific to the second passerby based on second information wirelessly

communicated between the gaming machine 10 and a second portable data unit 14 carried by the second passerby. (Ex. A, ¶ 48, Specification, p. 15, l. 33 to p. 16, l. 13).

Claim 120 generally relates to a method of operating a gaming terminal 10. (Ex. A, ¶ 11, Specification, p. 4, ll. 2-6, Figs. 1-2). The gaming terminal 10 is operated in a first mode associated with the passerby such that the gaming terminal 10 interacts with the passerby in a first manner in response to wirelessly detecting the presence of a passerby by at least one of detecting the presence of the passerby within a first predetermined distance of the gaming terminal or detecting the presence of the passerby for at least a first predetermined period of time. (Ex. A, ¶ 14, Specification, p. 5, ll. 11-19). The gaming terminal 10 is operated in a second mode associated with the passerby such that the gaming terminal 10 interacts with the passerby in a second manner different from the first manner in response to wirelessly detecting the presence of the passerby by at least one of detecting the presence of the passerby within a second predetermined distance of the gaming terminal 10 or detecting the presence of the passerby for at least a second predetermined period of time. (Ex. A, ¶¶ 14, 48, Specification, p. 5, ll. 19-25, p. 15, l. 33 to p. 16, l. 13).

6. GROUNDS FOR REJECTION TO BE REVIEWED ON APPEAL

I. Whether Claims 101-104 and 106-125 are improperly rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,908,387 (“Hedrick” attached as Exhibit C) in view of U.S. Patent No. 6,536,658 (“Rantze” attached as Exhibit D) as supported by U.S. Patent No. 5,923,252 (“Sizer” attached as Exhibit E).

In the April 28, 2009 Final Office Action, claims 101-104 and 106-125 were rejected under 35 U.S.C. 103(a) as being unpatentable over Hedrick in view of Rantze as supported by Sizer. With regard to claims 101, 102, 112 and 120, the Final Office Action asserted that Hedrick discloses establishing a wireless transmission link with a portable data unit with player tracking information. (Ex. B, p. 2). The Final Office Action also asserted that Hedrick discloses detecting the portable data unit within a predetermined distance and operates in an attract mode. (Ex. B, p. 2). The Final Office Action conceded that Hedrick fails to teach the attract mode occurs in response to detecting a portable data unit carried by a user within a first predetermined distance or time and a play mode. (Ex. B, pp. 2-3). The Final Office Action asserted that Rantze discloses a method of operating a retail terminal that includes operating in an attract mode and changing information on a screen as a user approaches. (Ex. B, p. 3). The Final Office Action concluded that it would be obvious to one of ordinary skill in the art to modify Hedrick with Rantze's method. (Ex. B, p. 3). The Final Office Action also cited Sizer as disclosing that different types of detection means may come in many forms. (Ex. B, p. 4).

7. ARGUMENT

A. Claims 101-104 And 106-125 Were Improperly Rejected Under 35 U.S.C. 103(a) As Unpatentable Over Hedrick In View Of Rantze And Sizer

Applicant respectfully submits that the Final Office Action impermissibly combined three disparate references to match the elements in the claims at issue. The primary reference, Hedrick, is from the gaming field and fails to disclose critical inventive features. The references relied upon to fill in these features, Rantze and Sizer, are drawn from the unrelated retail merchandizing field. Neither Rantze nor Sizer allows any information exchange between a

customer and the respective machines for the purpose of effecting machine operation associated with the individual.

1. The Deficiencies Of The Prior Art

Hedrick discloses a player tracking unit that may be attached to a gaming display on a gaming terminal. (Ex. C, Abstract). The player tracking unit may include a wireless interface device to allow player tracking information to be downloaded from a portable wireless device as an alternative to requiring a player to swipe a player ID card to obtain such information. (Ex. C, Col. 4, ll. 46-51). Thus, Hedrick is directed toward obtaining information specific to a player for gaming operations. The Final Office Action has conceded that Hedrick does not disclose an attract mode occurring in response to detecting a portable data unit carried by a user within a first predetermined distance or time. (Ex. B, p. 4). The Final Office Action also concedes that Hedrick does not disclose changing the mode of the machine on detecting the portable data unit within a second predetermined distance or time. (Ex. B, p. 4).

The Final Office Action has asserted that operating a device in different modes is well known in the art by citing Rantze. Rantze relates to a sales kiosk that uses a proximity sensor to sense the distance of an object, presumed to be a person, to the kiosk. (Ex. D, Abstract). However, Rantze is a retail information system and does not fall within the wagering game art as Hedrick or the present claims. Further, Rantze discloses an imprecise detection mechanism that is incapable of identifying whether an object is a person with certainty, let alone being capable of ascertaining the identity of such a person. Rantze functions by transmitting waveforms of different frequencies that are reflected from objects around the kiosk (assumed to be people). (Ex. D, Col. 10, l. 36 to Col. 11, l. 48, Fig. 3). The returned waveforms are received by a

detector and compared with a series of threshold amplitudes to determine the distance of the object from the detector. (Ex. D, Col. 11, ll. 28-42). Since Rantze relies only on returned waveforms bouncing off from an object, it cannot guarantee that the detected object is a person. The object may be inanimate such as another sales kiosk or in the case of a casino, a gaming machine. More importantly, Rantze's method cannot determine the identity of a person and therefore adjust the mode of the kiosk in a manner associated with the person according to information transmitted from the object.

The Sizer reference is similar to Rantze as Sizer discloses a marketing system where different messages may be provided depending on the detection of the proximity of an object, presumably a person. Specifically, Sizer discloses detection via an ultra-sonic sensor 2 in Fig. 1 which sends out ultra-sonic waves to detect the presence of an object presumed to be a person and a determination means 3 determines the presence of a person based on the data. (Ex. E, Col. 10, ll. 44-57). Thus, Sizer discloses the same type of detection mechanisms relied upon by Rantze, namely mechanisms that emit waves and detect reflections from an object and therefore do not communicate with the object. The Final Office Action has noted that other forms of detection mechanisms may be used other than ultra-sonic waves (Ex. B, p. 4), but the alternative methods in Rantze, such as infra-red beams, still suffer from the shortcomings of ultra-sonic waves, in so far as they do not communicate with the object. No data is exchanged with the object in the detection and ranging operations in either Sizer or Rantze.

The Final Office Action has asserted that the field of endeavor in Rantze and Sizer is reasonably pertinent to the particular problem in Hedrick because both the Rantze and Sizer devices operate in different modes based on the detection of the person. (Ex. B, p. 7). However,

the Final Office Action overgeneralizes the field of technology. Devices operating in different modes cannot be considered a common field of technology without some connection. Hedrick is not directed toward problems of operating in different modes and therefore simply operating in different modes does not place Rantze and Sizer in the same technology field as Hedrick.

2. The Wireless Communication System Of Hedrick Cannot Be Combined With the Passive Detection Systems In Rantze or Sizer

One of ordinary skill in the art would not combine Rantze with Hedrick regardless of a teaching of alternate forms of detection as outlined in Sizer. As explained above, Hedrick discloses the use of a wireless identification device that is a substitute for a player ID card for the purpose of sending player tracking information to the player tracking unit. (Ex. C, Abstract). There is no suggestion or motivation in Hedrick relating to the distance of a passerby with regard to a gaming machine function tailored to an individual player. The present claims relate to a wireless solution that solves the problem of players being annoyed and inconvenienced by having to insert their ID cards to activate individual player specific features on a machine. By a two way wireless communication link that also triggers different modes depending on the detection of the holder of the wireless personal data unit, the machine operation in the modes may be tailored to a specific player based on the information obtained through the link and not only because a person approaches the machine. In contrast, Rantze relies on motion detection via reflected waves. These reflected waves are not a communication link because at best they facilitate essentially one way information flow from the kiosk alone (the existence of an object) as the waves do not communicate any information from the object. Rantze cannot even insure that a person is in proximity from the kiosk. The substitution of other forms of detection such as ultra-sonic or infra-red beams as disclosed in Sizer are simply additional forms of the

fundamentally different motion detection function in Rantze that does not allow active communication between a portable device and the gaming machine.

The combination of Hedrick and the detection systems in Rantze/Sizer would not be contemplated by one of ordinary skill in the art. As noted above, the communication in Hedrick includes an exchange of information and thus, one of ordinary skill would not look to passive systems that do not exchange information such as Rantze or Sizer which rely on a passive, motion detection system of objects and not specific individuals.

a. The Inability To Combine References Physically Should Be Factored In A Lack Of Suggestion to Combine to One of Ordinary Skill In the Art.

One of ordinary skill would not combine different detection schemes in Hedrick and Rantze/Sizer together as the capabilities for each are not compatible. As explained above, a simple proximity system would not be sufficient to accomplish the purpose of Hedrick, namely obtaining information from a communication from a potential game player. There would be no motivation or suggestion to apply the feature of proximity detection in Rantze/Sizer to Hedrick as Hedrick is simply directed toward establishing communications with the portable unit for exchanging information with the portable unit.

The Final Office Action has asserted that MPEP 2145 (III) notes that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure, rather “the test is what the combined teaching of those references would have suggested to those of ordinary skill in the art.” (Ex. B, pp. 4, 7-8). The Final Office Action misinterprets Applicant’s arguments as to the impropriety of combining Rantze/Sizer with Hedrick. Applicant has noted that since Rantze/Sizer and Hedrick differ in respective operations

and purposes, one of ordinary skill would not have inferred the claims by the combined teachings of the references. The Office Action has asserted that one of ordinary skill in the art would modify Hedrick's detection system and incorporate Rantze's method of operating a device at different modes because Hedrick and Rantze are both directed to a detection system to operate a device. (Ex. B, pp. 4 and 7-8). However, the specific purposes of each detection system must be factored in the determination of what whether one detection system should be substituted for another because "the claimed combination cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose." MPEP 2145(III); *see also* MPEP 2143.01(V) ("If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification"). In this case, Rantze's detection system is essentially a one-way detection system while Hedrick is neither a detection nor a proximity system, it is actually a communication system. One of ordinary skill would not substitute Rantze or Sizer's types of detectors in Hedrick because Hedrick requires communication and the substitution of Rantze's detection system would render the other functions of Hedrick inoperable as the detectors in Rantze or Sizer could not exchange communication of information with the wireless device carried by a player. MPEP 2145 (III) cited by the Final Office Action specifically prohibits this type of combination stating "however, the claimed combination cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose." The suggested substitution would render Hedrick inoperable for the purpose of communication with the player wireless device. The combination is therefore improper.

b. The Differences Between the “Services” In Rantze and The Gaming Machines in Hedrick Would Be A Factor Against Combining The References

A second reason why one of ordinary skill would not combine Rantze with Hedrick is the difference between a retail sales environment with isolated kiosks to distribute marketing information to any person in proximity to the kiosks as in Rantze or Sizer and the gaming machine environment in Hedrick that caters to individual game players who may place wagers and operate the gaming machines. Rantze and Sizer are directed toward distributing marketing messages that are directed toward all persons within proximity of the kiosk in a retail environment and more specific messages once a person nears the kiosk. The motion detection methods of Rantze or Sizer would not function in a gaming machine environment (e.g., a casino) which has numerous machines and individuals, all in close proximity with each other. The gaming machine environment is therefore not a retail environment. The detection mechanisms that rely on the receipt of reflected waves from objects would not be able to isolate specific players, a feature which is desired by casinos for gaming machines such as the Hedrick system. The kiosk which is standalone in a retail environment will broadcast the same message to any potential customer thus not requiring specific customer identification. The dense placement of other large inanimate objects (gaming machines) in fixed proximity to the kiosk would make the proximity detection in Rantze and Sizer unworkable. Also, there are multiple people in the area of a gaming machine in a casino which also would not be amenable to the detection systems in Rantze or Sizer. The use of passive detectors in such an environment would cause the possibility of confusion as to which objects/persons are actually detected and used to change the operating mode of the machine.

The Final Office Action asserted that a gaming machine is a device that provides service to a person and this “service” is the same as “service providing systems” in Rantze. (Ex, B, p. 7). The standard cited by the Final Office Action for whether the references are in the same field is whether they are “reasonably pertinent” to the particular problem. In this instance, the references are in different fields as Hedrick is not the same type of “service” as Rantze and Sizer. A gaming machine requires a player to operate the machine and the change in machine operation language of the pending claims is premised on a player placing a wager and operating the gaming machine. There must be an exchange of communications to authorize the gaming machine in Hedrick as well as payment of a wager for the “service” of playing a game. In contrast, the “service” in Rantze and Sizer is simply broadcasting marketing messages that are displayed on the kiosk when an object is detected. Even if such systems were capable of receiving information, messages would be broadcast regardless of any information from the potential customers. Further, the machine operations in Rantze/Sizer are not geared toward attracting the customers to operate the machines in exchange for payment. The fields of marketing and casino game playing are not reasonably pertinent to each other and the combination is therefore incorrect.

3. The Combination of Hedrick, Rantze and Sizer Does Not Anticipate The Element Of “Modifying The Operation of the Machine” Based on The Individual In Claims 101, 102, 112 and 120

Even if one were to allow the combination of Hedrick, Rantze and Sizer, such a combination would not anticipate the element of modifying the operation of the machine associated with the passerby or individual. For example, claim 101 requires “changing the operation of the gaming terminal to a first mode associated with the individual or a second mode

associated with the individual.” Similarly, claim 102, 112 and 120 require a first and second mode associated with the passerby. The proximity sensing of Rantze or Sizer would only supply the distance of certain objects. The combination of Rantze and Sizer and Hedrick’s wireless communication would not have any correlation with the wireless communication since Rantze and Sizer relate to generic marketing messages and offering general information directed to all persons. The combination of these references would not teach associating the operation with the passerby or individual because there are many individual preferences and individual information could not be determined via the distance from the proximity detectors in Rantze and Sizer combined with the actual gaming machine operation of Hedrick.

The Final Office Action has asserted that Rantze and Sizer modifying the operation of the machine because the message changes. (Ex. B, pp. 9-10). As explained above, the kiosks in Rantze and Sizer have only one operation, namely the broadcast of information. Changing the type of information broadcast does not constitute a modification in the operation of the machine. Thus, the combination of Hederick with Rantze/Sizer would not anticipate this element and therefore these claims are allowable.

Conclusion

It is the Applicant's belief that all of the pending claims are in condition for allowance and action towards that end is respectfully requested.

If any matters may be resolved or clarified through a telephone interview, the Examiner is respectfully requested to contact the Applicant's undersigned attorney at the number shown.

Respectfully submitted,

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